UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,431	08/02/2000	Manuela Kunz	1222	3158

7590 07/28/2006

Striker Striker & Stenby
103 East Neck Road
Huntington, NY 11743

EXAMINER
KHAN, AMINA S

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/601,431	KUNZ ET AL.	
	Examiner	Art Unit	
	Amina Khan	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7-9 and 11-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-9 and 11-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☒ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/4/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 4, 2006 has been entered.

2. Claims 7-9 and 11-21 are pending.

3. The allowability of claims 7-9 and 11-21 is withdrawn. Prosecution on the merits of this application is reopened on claims 7-9 and 11-21 considered unpatentable for the reasons indicated below:

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 7,11,12,15 and 21 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U. S. Patent No. 6,652,601. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent and instant application both teach multicomponent kits comprising component (A) which comprises the instantly claimed enamine compounds mixed with a carbonyl compound and component (B) which comprises a decolorizing

agent comprising at least one sulfite. While the formula disclosed by the instant application is not identical to the formula disclosed by the patent, the formula disclosed by the patent is a subset of that disclosed by the instant application.

6. Claim 18 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U. S. Patent No. 6,669,739. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent and instant application both teach methods of dyeing and later decolorizing hair in which the hair is temporarily colored with component (A) which comprises the instantly claimed enamine compounds mixed with a carbonyl compound and later decolorized with component (B) which comprises a decolorizing agent comprising at least one sulfite, wherein the sulfite preparation is allowed to act on the colored hair for a period of 5 to 60 minutes at a temperature of 20-50°C. While the formula disclosed by the instant application is not identical to the formula disclosed by the patent, the formula disclosed by the patent is a subset of that disclosed by the instant application.

7. Claim 18 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over over claim 10 of U. S. Patent No. 6,740,128. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent and instant application both teach methods of dyeing and later decolorizing hair in which the hair is temporarily colored with component (A)

which comprises the instantly claimed enamine compounds mixed with a carbonyl compound and later decolorized with component (B) which comprises a decolorizing agent comprising at least one sulfite, wherein the sulfite preparation is allowed to act on the colored hair for a period of 5 to 60 minutes at a temperature of 20-50°C. While the formula disclosed by the instant application is not identical to the formula disclosed by the patent, the formula disclosed by the patent is a subset of that disclosed by the instant application.

8. Claims 13 and 14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,652,601 in view of Raue et al. (US 4,513,142).

US Patent 6,652,601 is relied upon as set forth above. US Patent 6,652,601 further teaches dyeing and decolorizing natural or man made fibers such as cotton, wool and nylon with mixtures of enamine and carbonyl compounds (column 8, lines 1-5).

US Patent 6,652,601 is silent as to the specific enamine and carbonyl compounds used in the multicomponent kits and does not explicitly teach the instantly claimed compounds.

Raue et al., in the analogous art of dyeing natural fibers (column 6, lines 24-32) teaches mixing 1,3,3-trimethyl-2methylindoline with 4-dimethylaminobenzaldehyde (column 4, lines 15-68) to provide a dyestuff suitable for dyeing natural fibers such as cotton and polyamide.

It would have been obvious to one of ordinary skill in the art to modify the multicomponent kits of US Patent 6,652,601 by incorporating the enamine and carbonyl compounds taught by Raue et al. because Raue et al. teaches mixtures of these compounds as effective compositions for dyeing natural substrates. One of ordinary skill in the art would have been motivated to combine the teachings of the references absent unexpected results.

9. Claims 16 and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6,8 and 9 of U.S. Patent No. 6,652,601. Although the conflicting claims are not identical, they are not patentably distinct from each other because although claims 6 and 8 of the patent don't recite a multicomponent kit with a sulfite, the kit is clearly taught in claim 9 of the patent.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to put the enamine and carbonyl compounds taught in claims 6 and 8 of the patent into a multicomponent kit comprising a sulfite as taught in claim 9 of the patent because it is well known in the hair dyeing art to put dye and decolorizing compositions in multicomponent kits for convenient distribution to the consumer. The burden is on the applicant to prove otherwise.

10. Claims 18 is rejected on the ground of nonstatutory double patenting over claim 10 of U. S. Patent No. 7,056,348 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the patent and instant application both teach methods of dyeing and later decolorizing hair in which the hair is temporarily colored with component (A) which comprises the instantly claimed enamine compounds mixed with a carbonyl compound and later decolorized with component (B) which comprises a decolorizing agent comprising at least one sulfite, wherein the sulfite preparation is allowed to act on the colored hair for a period of 5 to 60 minutes at a temperature of 20-50°C.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

11. Claims 8 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,652,601 in view of Kunz et al. (US 6,171,347).

US Patent 6,652,601 is relied upon as set forth above.

US Patent 6,652,601 is silent as to the type of sulfites used in the multi-component kit and the percentages of the sulfites and does not explicitly teach this claimed limitation.

Kunz et al. teaches multicomponent kits comprising decolorizing agents comprising 0.1-10% by weight alkali or alkaline earth sulfites (column 10, lines 4-11).

It would have been obvious to one of ordinary skill in the art to modify the teachings of US Patent 6,652,601 by incorporating 0.1-10% by weight alkali or alkaline earth sulfites as taught by Kunz et al. because Kunz et al. teaches the utility of these particular sulfites at the claimed percentages as effective decolorizing agents for decolorizing hair dyes. One of ordinary skill in the art would have been motivated to combine the teachings of the references absent unexpected results.

12. Claims 19 and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,740,128 in view of Kunz et al. (US 6,171,347).

US Patent 6,740,128 is relied upon as set forth above.

US Patent 6,740,128 is silent as to the type, pH and weight percentages of sulfites used in the decolorizing methods and the time and temperature parameters for use of the dye in the dyeing methods and does not explicitly teach these claimed limitations.

Kunz et al. teaches methods of temporarily dyeing and then decolorizing hair in which the dyeing is performed for 5 to 60 minutes at a temperature of 20-50°C (column 9, lines 25-45) and the decolorizing preparation comprises 0.1-10% by weight alkali or alkaline earth sulfites at a pH between 1.8 to 6 (column 10, lines 4-56).

It would have been obvious to one of ordinary skill in the art to modify the dyeing/decolorizing methods of US Patent 6,740,128 by incorporating the dyeing methods and sulfite preparations taught by Kunz et al. because Kunz et al. teaches the utility of dyeing parameters and these particular preparations as effective dyeing and decolorizing agents for use on hair. One of ordinary skill in the art would have been motivated to combine the teachings of the references absent unexpected results.

13. Claims 19 and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,669,739 in view of Kunz et al. (US 6,171,347).

US Patent 6,669,739 is relied upon as set forth above.

US Patent 6,669,739 is silent as to the type, pH and weight percentages of sulfites used in the decolorizing methods and the time and temperature parameters for use of the dye in the dyeing methods and does not explicitly teach these claimed limitations.

Kunz et al. teaches methods of temporarily dyeing and then decolorizing hair in which the dyeing is performed for 5 to 60 minutes at a temperature of 20-50°C (column 9, lines 25-45) and the decolorizing preparation comprises 0.1-10% by weight alkali or alkaline earth sulfites at a pH between 1.8 to 6 (column 10, lines 4-56).

It would have been obvious to one of ordinary skill in the art to modify the dyeing/decolorizing methods of US Patent 6,669,739 by incorporating the dyeing methods and sulfite preparations taught by Kunz et al. because Kunz et al. teaches the

utility of dyeing parameters and these particular preparations as effective dyeing and decolorizing agents for use on hair. One of ordinary skill in the art would have been motivated to combine the teachings of the references absent unexpected results.

14. Claims 19 and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 7,056,348 in view of Kunz et al. (US 6,171,347).

US Patent 7,056,348 is relied upon as set forth above.

US Patent 7,056,348 is silent as to the type, pH and weight percentages of sulfites used in the decolorizing methods and the time and temperature parameters for use of the dye in the dyeing methods and does not explicitly teach these claimed limitations.

Kunz et al. teaches methods of temporarily dyeing and then decolorizing hair in which the dyeing is performed for 5 to 60 minutes at a temperature of 20-50°C (column 9, lines 25-45) and the decolorizing preparation comprises 0.1-10% by weight alkali or alkaline earth sulfites at a pH between 1.8 to 6 (column 10, lines 4-56).

It would have been obvious to one of ordinary skill in the art to modify the dyeing/decolorizing methods of US Patent 7,056,348 by incorporating the dyeing methods and sulfite preparations taught by Kunz et al. because Kunz et al. teaches the utility of dyeing parameters and these particular preparations as effective dyeing and decolorizing agents for use on hair. One of ordinary skill in the art would have been motivated to combine the teachings of the references absent unexpected results.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amina Khan whose telephone number is (571) 272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amina Khan

Amina Khan
Patent Examiner
July 8, 2006

Lorna M. Douyon

LORNA M. DOUYON
PRIMARY EXAMINER